

Remarks

Claim Status:

Claims 1-17 are pending. Dependent claim 17 is newly presented.

Art-based Rejection:

Claims 1-5 and 8-16 are rejected as being unpatentable over Daly-819 in view of Lawler. Claims 6 and 7 are rejected as being unpatentable over Daly-819 in view of Cass.

We respectfully traverse these rejections.

Claim 1

The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [Graham] factors continue to define the inquiry that controls.”)

Additionally, it is elementary that to support an obviousness rejection, all of the claim limitations must be taught or suggested by the prior art applied (*see In re Royka*, 490 F.2d 981, 984-85 (CCPA 1974)) and that all words in a claim must be considered in judging the patentability of that claim against the prior art (*see In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970)).

Even if Daly-819 and Lawler are combined as suggested in the Office Action, all of the claim limitations as recited in claim 1 would not be present and would not be obvious there from.

For example, claim 1 recites adjusting an image in accordance with values in a first representation utilized by a printing process; determining values to convey a digital watermark in the adjusted image; adjusting the values in accordance with a second representation utilized by the printing process; and combining the adjusted change values and the image to produce a digital watermarked image.

The Office Action recognizes Daly's deficiencies and relies Lawler as showing a first (i.e., fig 6) and second (i.e., fig. 7) representations being utilized by a printing process. *See* the Office Action, page 4, lines 1-6.

We respectfully disagree with this analysis.

For example, the different Lawler representations do not – respectively – adjust an image (fig. 6) and adjust values to convey a digital watermark (fig. 7) as would be required by claim 1. So even if combined as suggested, the resulting combination would not yield the recited combination.

This position does not individually attack a reference as suggested in the Office Action, page 2, under “Examiner’s Response”. Rather, this position is presented to show that, even if combined as suggested, the Daly-819 and Lawler documents do not have or render obvious all of the claim features.

Thus, the differences between the subject matter sought to be patented (claim 1) and the prior art are such that the subject matter as a whole would not have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Claim 1 stands ready for allowance over the applied art.

Claim 8

Claim recites – in combination with other features – altering color values of an image by an amount to achieve change values, *the amount includes a compensation for a variation in a relationship of an input color value* and at least one of ink and dye provided by a printing process to represent the input color value.

The Office Action recognizes Daly's deficiencies in this regard and relies Lawler to cure such deficiencies. *See* the Office Action, page 5, line 13 – page 6, line 4.

We respectfully disagree with the position as stated in the Office Action.

For example, the cited Lawyer passages discuss a corrective curve to counteract effects of gain. We ask for further clarification during the upcoming interview if the Examiner intends to maintain this position.

Otherwise, we respectfully request that claim 8 be allowed over the applied art.

Claim 12

Claim 12 recites – in combination with other features of the claim – receiving a representation of a variation in a relationship of an input color value and at least one of ink and dye provided by the printing process to represent the input color value.

Like claim 8 above, we ask that the Examiner be prepared to discuss these features in view of Lawler during the interview.

Otherwise, we respectfully request that claim 12 be allowed over the applied art.

Remaining Claims

We respectfully request reconsideration of the remaining dependent claims as well.

Conclusion:

We look forward to our upcoming interview. Otherwise, we respectfully request a Notice of Allowance. The Examiner is respectfully invited to contact the undersigned with any questions and to arrange a mutually convenient time for an interview.

Date: June 10, 2008

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Respectfully submitted,

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